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| EXAMINER | |
|---|---|
| HALIM, SAHERA | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/931,590 | NEWNAM ET AL. | |
| | Examiner | Art Unit | |
| | SAHERA HALIM | 2457 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *03 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-7,9,10,12-19,28-37 and 42-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,10,12-19,28-37 and 42-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/6/08, 12/3/08, 6/9/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

**1.** This action is responsive to the Amendment filled on 12/3/2008.

**2.** Claims 1-7, 9-10, 12-19, 28-37, and 42-47 are pending.

**3.** Claims 8, 11, 20-27, and 38-41 have been cancelled.

**4.** Claims 45-47 have been added.

### *Claim Objections*

5. Claim 34 objected to because of the following informalities: Claim 34 depends on itself. For examination purposes claim 34 dependents on claim 33. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 6-7, 9, 12-13, 19, 28, 29, 31-32, 35, and, 42-47 are under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub No. 2002/0162118 to Levy et al.

8. As per claims 1, 13 and 30, Levy et al. teaches a method and system for a enhancing a broadcast event for a plurality of remote viewers each having a client device including a local storage device and a personal interactivity recorder (PIR) for storing and playing back interactive content along with playback of the broadcast event

and playing back the broadcast event, and an interactive television system for storing and playing back an enhanced video program, the method and system comprising (see abstract and Fig. 1):

local storage device (set-top box 102) receiving and storing the broadcast event in a first data store as the broadcast event is being broadcast via a broadcast event signal to the remote viewers during a first time period (see par. 0042 a consumer 25 receives content via set-top box for viewing);

PIR coupled to the local storage device receiving interactive content provided from a server system separately from the broadcast of the broadcast event and not embedded in the broadcast event signal, the interactive content being related to the broadcast event, the same interactive content being configured to be displayed by client device during the first time period (see par. 0042, a back channel 36 is used to receive interactive content and see par. 0014; the interactive data is maintained separately);

PIR associating the interactive content received from the server system to the broadcast event and storing the associated interactive content in a second data store (see par. 0056, the interactive content can saved in different databases);

a particular one of the client devices retrieving the stored broadcast event from the first data store and the stored interactive content from the second data store in response to a user command (par. 0004; a remote or interactive mouse is used to request content by the viewer); and

the particular one of the client devices playing back the retrieved broadcast event from storage during a second time, wherein when the retrieved broadcast event is

played back during the second time period, the corresponding PIR provides to the user the interactive content at one or more times during the retrieved broadcast event when the interactive content would have been displayed when the broadcast event was being broadcast, during the first time period (see par. 0121- par. 0126; the program is played back in the same manner as the first time).

Although the method disclosed by Levy et al. shows substantial features of the claimed inventions, it fails to explicitly teach more than one local storage devices and viewers. However, Levy teaches a single storage device and viewer, thus it would have been obvious for a person having ordinary skill in the art at the time of the invention to recognize the desirability and advantageous of modifying Levy et al. by employing the well known or conventional features of broadcasting to multiple users in order to increase profitability.

9. As per claims 6, and 19, Levy et al. teaches the method of claim 1, wherein the interactive content and video broadcast event are stored on the same medium (see Fig. And Fig 9 and par. 0103).

10. As per claim 7, Levy et al. teaches the method of claim 1, wherein the PIR uses the processing and storing functionality of the local storage device (see fig. 9 and par. 0103; set top box and its memory).

11. As per claim 9, Levy et al. teaches the method of claim 1, wherein the local storage device includes a hard drive (the VCR and DVD par. 121).

12. As per claim 12, Levy et al. teaches the method of claim 1, wherein the PIR includes processing and storage separate form the local storage device (par. 0014 and 0067).

13. As per claims 28, 29 and 35, Levy et al. teaches the method and system of claims 1, 13 and 30 wherein the interactive content provided by the PIR and at the broadcast time of the broadcast event is not targeted interactive content that is based on individualized viewer profile information (par. 0032).

14. As per claim 31, Levy et al. teaches the system of claim 30, wherein the first local storage medium is the same as the second local storage medium (par. 0066).

15. As per claim 32, Levy et al. teaches the system of claim 30, wherein the first recording device is the same as the second recording device (par. 0032).

16. As to claim 42, Levy et al. teach wherein the broadcast event is broadcast of a video program that contains no embedded triggers associated with the interactive content (see summary).

17. As to claim 43, Levy et al. teach wherein the interactive content is an on-line program transmitted by the server system over a wide area network and synchronized with the video program (see Fig. 8, and Fig. 12).

18. As to claim 44, Levy et al. teach wherein the first recording device recording the video program is a personal video recorder (PVR) and the second recording device recording the interactive data is a PIR separate from the PVR for recoding the interactive data separately from the video program (see Fig. 12).

19. As to claim 45, Levy et al. teach the system of claim 1, wherein the interactive content includes interactive content triggers (see summary).

20. As to claim 46, Levy et al. teach the system of claim 45, wherein the stored interactive content includes information associating the interactive content to the broadcast event (see summary and background).

21. As to claim 47, Levy et al. fail to explicitly teach wherein the information is a video frame marker. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have any type of information in order to satisfy the specific needs of system.

22. Claims 4-5, 16, 33, 37, and 17 are under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub No. 2002/0162118 to Levy et al. in view of US. Pat. NO. 6,766,534 to Matheny et al. (hereinafter Matheny).

23. As per claims 4 and 16 and 17, Levy et al. fail to teach system of claims 1 and 13 wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question. However, Matheny teaches the method ands system of claims 1 and 13 wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question (column 3, lines 30-45; column 5, lines 34-67). It would have been obvious for a person having ordinary skill in the art at the time of the invention to combine the conventional interaction content of Matheny with the invention of Levy in order to increase user interaction and customization of broadcast content.

24. As per claims 5, 37 and 18, Levy et al. fail to teach the method of claims 1, 30 and 13, wherein the interactive content includes poll questions, the PIR storing poll results, the user has an input device for entering a response, and the PIR provides poll results after the user enters a response to the poll question. However, Matheny

teaches the method of claims 1 and 13, wherein the interactive content includes poll questions, the PIR storing poll results, the user has an input device for entering a response, and the PIR provides poll results after the user enters a response to the poll question (column 3, lines 30-45; column 5, lines 34-67). It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Levy with the polling of Matheny in order to enhance user customization.

25. As per claim 33, Levy et al. fail to teach the system of claim 30 further comprising: a user input device operable coupled to each client device for transmitting a video control message to the first and second recording devices, the first and second recording devices being configured to separately perform a corresponding action on respectively the video program and interactive content in response to the video control message. However, Matheny teaches the system of claim 30 further comprising: a user input device operable coupled to each client device for transmitting a video control message to the first and second recording devices, the first and second recording devices being configured to separately perform a corresponding action on respectively the video program and interactive content in response to the video control message (column 6, lines 40-67). It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Levy by messaging of Matheny in order to enhance system usability.

26. Claim 2, 14, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. et al. in view of Dunn et al. US Patent No. 5,517,257.

27. As to claim 2, 14, 34 and 36 Levy et al. teach the method and system of claims 1, 13 and 30 Levy et al. do not expressly teach wherein the local storage device includes functionality for fast forward, rewind, and pause functions. Dunn teaches the local storage device includes functionally for fast forward, rewind, and pause functions. See column 5, lines 39-60. However, the concept and advantages of fast forward, rewind and pause functions is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the VCR and set top box function of Levy et al. with fast forward, rewind and pause functions. A person of ordinary skill in the art would have been motivated to do this to allow the user to view the event conveniently.

28. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. et al. in view of Bolnick et al. US Patent Publication No. 2002/0023230. Levy et al. teaches the method of claim 1. Levy et al. do not teach wherein the PIR stores and plays back messages sent by other viewers using chat functionality during the broadcast event. Bolnick teaches wherein the PIR stores and plays back messages sent by other viewers using chat functionality during the broadcast event. See paragraph 0034 and claim 12. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the chat functionality of Bolnick with the

broadcast event of Levy et al. A person of ordinary skill in the art would have been motivated to do this to enhance the interactivity of the session between a student and a teacher.

**It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonable suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968))**

***Response to Arguments***

29. Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (571) 272-4003. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim

Art Unit: 2457

/ARIO ETIENNE/
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